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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,543	12/04/2001	James H. Jannard	OAKLY1.172C1	8406
20995	7590	11/30/2004	EXAMINER	
KNOBBE MARTENS OLSON & BEAR LLP			DANG, HUNG XUAN	
2040 MAIN STREET			ART UNIT	
FOURTEENTH FLOOR			PAPER NUMBER	
IRVINE, CA 92614			2873	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/004,543

Applicant(s)

JANNARD ET AL.

Examiner

Hung X Dang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

1. The amendment filed on 9/7/04 has been entered.

### **Claims Rejection Under 35 USC - 103**

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Spitzer** (6,349,001) in view of **Vaudrey et al** (6,311,155).

Spitzer discloses industrial safety assembly including disposable ear protection and earphone which comprises a telecommunications receiver carried inside of the eyeglass, telecommunications transmitter carried inside of the eyeglass, a battery carried by the eyeglass, a pair of earphones and a microphone is connected to an orbital.

Spitzer does not disclose the storage device comprises an MP3 storage device.

However, Vaudrey et al discloses a personal listening device (PLD) attached to the eyeglasses (see column 8, lines 40-46) wherein the personal listening device (PLD) is a MP3 playback devices (see column 23, lines 1-21.)

Because Spitzer and the Vaudrey et al are both from the same field of endeavor, the purpose of storage the music as disclosed by Vaudrey et al would have been recognized as an art pertinent art of Spitzer.

It would have been obvious, therefore, at the time the invention was made to a person having skill in the art to construct the eyeglasses frame, such as the one disclosed by Spitzer, with MP3 playback device, such as disclosed by Vaudrey et al for the purpose of storing and listening the music.

### Response To Applicant's Argument

3. Applicant's arguments filed 9/7/04 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

In lines 40-63 of Column 8, Vaudrey et al teach:

"For multiple users in the same environment, a separate adjustment of the VRA can be accomplished if each user is listening to a program on a personal listening device (PLD) which may include but is not limited to headphones, hearing aids, cochlear implants, assistive listening devices, **eyewear or headwear that incorporates speakers**. Such **eyewear** may include, for example, **eyeglasses worn with speakers**, or wearable computers. A PDU as used in this context will be defined to mean an audio reproduction device capable of receiving an electrical or wireless signal and converting it into audible sound in a manner that does not disturb other listeners in the same general environment.

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After reception of the two (or more) signals at the personal listening device, the signals are separately adjusted by independent volume controls (or other types of controls as described later) so that a preferred VRA for that individual user is achieved. The signals are then combined, and further amplified and adjusted and transduced by the personal listening device to become audible sound. Since the personal listening device is not interfering with others in the same listening environment who may also have a personal listening device (with a different preferred VRA setting), multiple listeners in the same environment can independently adjust the VRA for their own listening pleasure."

In lines 1-21 of Column 23, Vaudrey et al teach:

"The above discussion focused on providing the end user with the ability to adjust the VRA of electronically reproduced media (either broadcast playback or **recording playback**) on personal listening devices PLD's so that individual listeners in the same environment can enjoy different VRA ratios simultaneously. Further inventions are made when the personal listening devices described above are extended to include the following electronics:

Cellular telephones

Wearable Computers

Personal data assistants

**MP3 playback devices**

Personal audio players that use magnetic storage media to store the music. These devices can be used for personal level **playback of music** or audio containing dialog and remaining audio that might obscure the dialog. The embodiments discussed in the previous sections can be applied to the four devices listed above to provide VRA adjustment for the playback of audio that has been prerecorded or produced with the dialog separate from the remaining audio regardless of the coding format."

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4. Any inquiry concerning this communication should be directed to Examiner Hung Dang at telephone number (703) 308-0550.

11/04

A handwritten signature in black ink, appearing to read 'Hung Dang', with a stylized, flowing script.

HUNG DANG

PRIMARY EXAMINER

ART UNIT 2873